

REMARKS

This paper is filed in response to the office action mailed on April 2, 2008. In the office action, claims 1-18 are rejected. More specifically, claim 7 is objected to due to an informality; claims 1-2, 8-9 and 11-12 are rejected under 35 USC §102 as being anticipated by U.S. Patent No. 1,994,519 ("James"); claims 3, 7, 10 and 14-17 are rejected under 35 USC §103 as being obvious in view of James; claim 4 is rejected under 35 USC §103 as being obvious in view of James and U.S. Patent No. 1,937,957 ("Hotchner"); and claims 5-6 and 13 are rejected under 35 USC §103 as being unpatentable in view of James and of U.S. Patent No. 4,811,507 ("Blanchet").

In response, claims 2 and 4 been cancelled and claims 1, 7 and 10 have been amended to traverse all rejections and place this application in a condition for allowance. Support for the amendments to claim 1 can be found in original claims 2 and 14 and on page 1, lines 23-28 of the priority PCT application. The typographical error of claim 7 has been corrected. The prior art rejections have been traversed as set forth below.

Turning to the anticipation rejections of claims 1-2, 8-9 and 11-12, applicants respectfully submit that these rejections are now improper and must be withdrawn. Specifically, under MPEP § 2131,

"[t]o anticipate a claim, the reference must teach every element of the claim. 'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.'" *Citing, Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Amended claim 1 includes at least three features not taught or suggested by James. First, James does not teach or suggest a three-dimensional body that comprises a convex outer surface. The James glass characters 15a do not include a convex surface. Second, James does not teach or suggest a light source with a color temperature of at least 5000°K. James is directed toward a neon sign and colored neon light sources have color temperatures of substantially less than 5000°K. Third, the portion 16 of the James plate 11 that serves as a background for the lettering is preferably a "colored material 16, such as brightly colored felt" to give "background to the advertising legend and when the tube is operating makes the legend more prominent." James, at column 1, line 55 to column 2, line

5. In stark contrast, the portion of the light transmitting plate of amended claim 1 to which the three-dimensional body is mounted is clear to provide the impression that the three-dimensional body is floating as recited in amended claim 1.

Accordingly, because there are at least three features of amended claim 1 not found in James, the anticipation rejections of claims 1-2, 8-9 and 11-12 are improper and must be withdrawn.

Turning to the obviousness rejections, applicant respectfully submits that all of the obviousness rejections are improper because no combination of James, Hotchner or Blanchet teaches or suggests all of the elements of amended independent claim 1. Specifically, to support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered” and MPEP § 2141.02 requires consideration of the “[claimed] invention and prior art as a whole.” Further, the Board of Patent Appeals and Interferences recently confirmed that a proper, post-KSR obviousness determination still requires the Patent Office make “a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.” *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) and *CFMT v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003).

In sum, it remains well-settled law that an obviousness rejection requires at least a suggestion of *all* of the claim elements. No combination of James, Hotchner and Blanchet suggest all the claim elements and therefore the office action fails to establish a *prima facie* case of obviousness.

Specifically, the deficiencies of James are addressed above. James does not teach or suggest the three-dimensional body with the convex outer surface of amended claim 1. James does not teach or suggest a light source with a color temperature exceeding 5000°K. Instead, James is directed toward a neon sign, the types of signs that the claimed invention will replace. Further, James in no way teaches or suggests a three-dimensional structure that appears to be floating as the background portion 16 of the plate 11 of James was intended to be colored, not clear. Accordingly, the rejections of claims 3, 7, 10 and 14-17 as being obvious in view of James are traversed.

With respect to the rejection of claim 4, while Hotchner teaches the use of grooves in an illuminated sign, Hotchner does not teach or suggest the three-dimensional

body that would be placed are mounted in such a groove. Further, Hotchner does not teach or suggest the light source with the high color temperature or the clear background for three-dimensional light-transmissive bodies with convex outer surfaces that provide the floating appearance. Therefore, Hotchner cannot supplement James with respect to any of these three prominent differences and the obviousness rejection of claim 4 based on James and Hotchner is traversed.

With respect to the obviousness rejections of claims 5-6 and 13, Blanchet is merely cited for the proposition that it teaches deep grooves or striations 4 in an illuminated device. Blanchet does not teach or suggest the three-dimensional body with a convex outer surface that would be placed in such a groove or striation, the high color temperature of the light source or the clear background for the three-dimensional light-transmissive body as recited in amended independent claim 1. All three of these features are missing from both James and Blanchet and therefore the obviousness rejections of claims 5-6 and 13 are traversed.

The fee for a three-month extension of time was paid electronically with the filing of this document. Applicants respectfully submit that no other fees are due at this time. However, the Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 50-3629.

Dated: October 2, 2008

Respectfully submitted,

By


Michael R. Hull

Registration No.: 35,902

MILLER, MATTHIAS & HULL

One North Franklin Street

Suite 2350

Chicago, Illinois 60606

(312) 977-9905

Attorney for Applicants